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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHUKWURAH, NATHANIEL C

ART UNIT PAPER NUMBER

3721

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/655,822

Applicant(s)

HEZELTINE, ALTON W.

Examiner

Nathaniel C. Chukwurah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,4-6 and 9-11 is/are rejected.
7) ☒ Claim(s) 2,3,7,8,12 and 13 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/12/2004.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 8, 11 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites that “the control mechanism provides vacuum to the supply hose when air pressure within the pilot hose has greater than a predetermined pressure and further the control mechanism provides air pressure to the supply hose when air pressure within the pilot hose has less than a predetermined pressure”. However, the specification, page 17, lines 9-12 describes that the reversing valve 60 is coupled to line 44, line 64, line 74, and supply hose 86. When line 64 from limit valve 80 is not pressurized, vacuum is connected from line 74 to supply hose 86. When line 64 is pressurized, air pressure is connected to supply hose from line 44.

Note that line 64 is not a pilot hose according to the original filed specification.

Similarly, claims 3, 8, 11 and 13 are also rejected for setting forth the condition of the pilot hose in the same manner.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-3, 8, 11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because the condition set forth in claims lack proper antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hood (US 5,352,230).

With regard to claim 1, Hood discloses a tool control system comprising: a pneumatic source (178, compressed gas tank), a vacuum source (180), a control mechanism (12) coupled to the pneumatic source, to a vacuum source, to a supply hose (86), a pilot hose (90); and the supply hose and pilot hose are coupled to the tool (14).

Hood's control mechanism (12) provides vacuum to the supply hose (86) when air pressure within the pilot hose has greater than a predetermined pressure and further the control mechanism (12) provides air pressure to the supply hose (86) when air pressure within the pilot hose has less than a predetermined pressure (col. 14, lines 42-47).

With regard to claim 10, Hood shows a supply hose selectively coupleable to air or vacuum source (fig. 1); and supply (86) and pilot (96) hoses are coupled to the tool.

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With regard to claim 11, Hood shows a control mechanism providing vacuum to the supply hose (86) when air pressure within the pilot hose has greater than a predetermined pressure and further providing air pressure to the supply hose (86) when air pressure within the pilot hose has less than a predetermined pressure (col. 14, lines 42-47).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hood in view of Erickson et al. (US 2,679,645).

With regard to claim 4, Hood shows a system (10) comprising: an air source (178), a vacuum source (180), a control mechanism (12) coupled to the air source and to the vacuum source; the air source and the vacuum source are coupled to a tool (14) comprising: a first actuation element (200 foot pedal). Hood's control mechanism (12) provides vacuum and pressure to the tool when one actuation element is actuated.

With regard to claim 9, Hood shows a system (10) comprising: an source (178), a vacuum source (180), a control mechanism (12) coupled to the air source and to the vacuum source; and the control mechanism is coupled to a tool (14) comprising: a first actuation element (200 foot pedal); a pilot hose (90) coupled to the control mechanism (12) wherein air within the pilot hose has less than a predetermined pressure when one actuation element (200 foot pedal) is

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actuated and wherein air within the pilot hose has greater than a predetermined pressure when the actuation element (200 foot pedal) is actuated.

Hood lacks a second operator-depressible actuation element.

However, Erickson et al. teaches first operator-depressible actuation element (48 trigger) and second operator-depressible actuation element (28 sleeve) which actuates when pressed against a surface, for driving the stud (21) into a workpiece.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the pneumatic tool of Hood with first and second operator-depressible actuation elements as taught by Erickson et al. in order to provide pressure and vacuum respectively to tool of Hood.

With regard to claim 5, Hood shows a supply hose (86) selectively coupleable to the air source or vacuum source; a pilot hose (90) coupled to the first operator-depressible actuation element (200, foot pedal); and both supply and pilot hoses are coupled to the tool (14).

With regard to claim 6, Hood shows control mechanism (12) provides vacuum to the supply hose (86) when air pressure within the pilot hose has greater than a predetermined pressure and further the control mechanism (12) provides air pressure to the supply hose (86) when air pressure within the pilot hose has less than a predetermined pressure (col. 14, lines 42-47).

Allowable Subject Matter

Claims 2, 3, 8 and 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Claims 7 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 3/28/2005 have been fully considered but they are not persuasive.

Applicant argues that Hood fails to disclose a control mechanism which provides vacuum to the supply hose when air within pilot hose has less than a predetermined pressure and/or air pressure to supply hose when air within the pilot hose has greater than the predetermined pressure.

However, the specification, page 17, lines 9-12 describes that the reversing valve 60 is coupled to line 44, line 64, line 74, and supply hose 86; and when line 64 from limit valve 80 is not pressurized, vacuum is connected from line 74 to supply hose 86, and when line 64 is pressurized, air pressure is connected to supply hose from line 44. Note that line 64 is not a pilot hose.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathaniel C. Chukwurah whose telephone number is (571) 272-4457. The examiner can normally be reached on M-F 6:00AM-2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NC

June 3, 2005.


LOUIS K. HUYNH
PRIMARY EXAMINER